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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,704	06/01/2001	Randy L. Morningstar	687-442	2503
40636	7590	06/26/2006		
AMS RESEARCH CORPORATION 10700 BREN ROAD WEST MINNETONKA, MN 55343			EXAMINER MITCHELL, TEENA KAY	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/872,704	MORNINGSTAR, RANDY L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Teena Mitchell	3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 52-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 52-61 is/are allowed.
- 6) ☒ Claim(s) 1,8 and 11-19 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Allowable Subject Matter***

The indicated allowability of claims 1-10 is withdrawn after further review of the reference(s) to Pecenka (4,517,979). Rejections based on the Pecenka reference(s) follow.

### ***Claim Rejections - 35 USC § 112***

**The following is a quotation of the second paragraph of 35 U.S.C. 112:**

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

**Claims 11-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In claim 11, lines 8 and 12, "...extending upwardly from said valve body..." it is unclear as to what constitutes upwardly with respect to the valve body.

### ***Claim Rejections - 35 USC § 102***

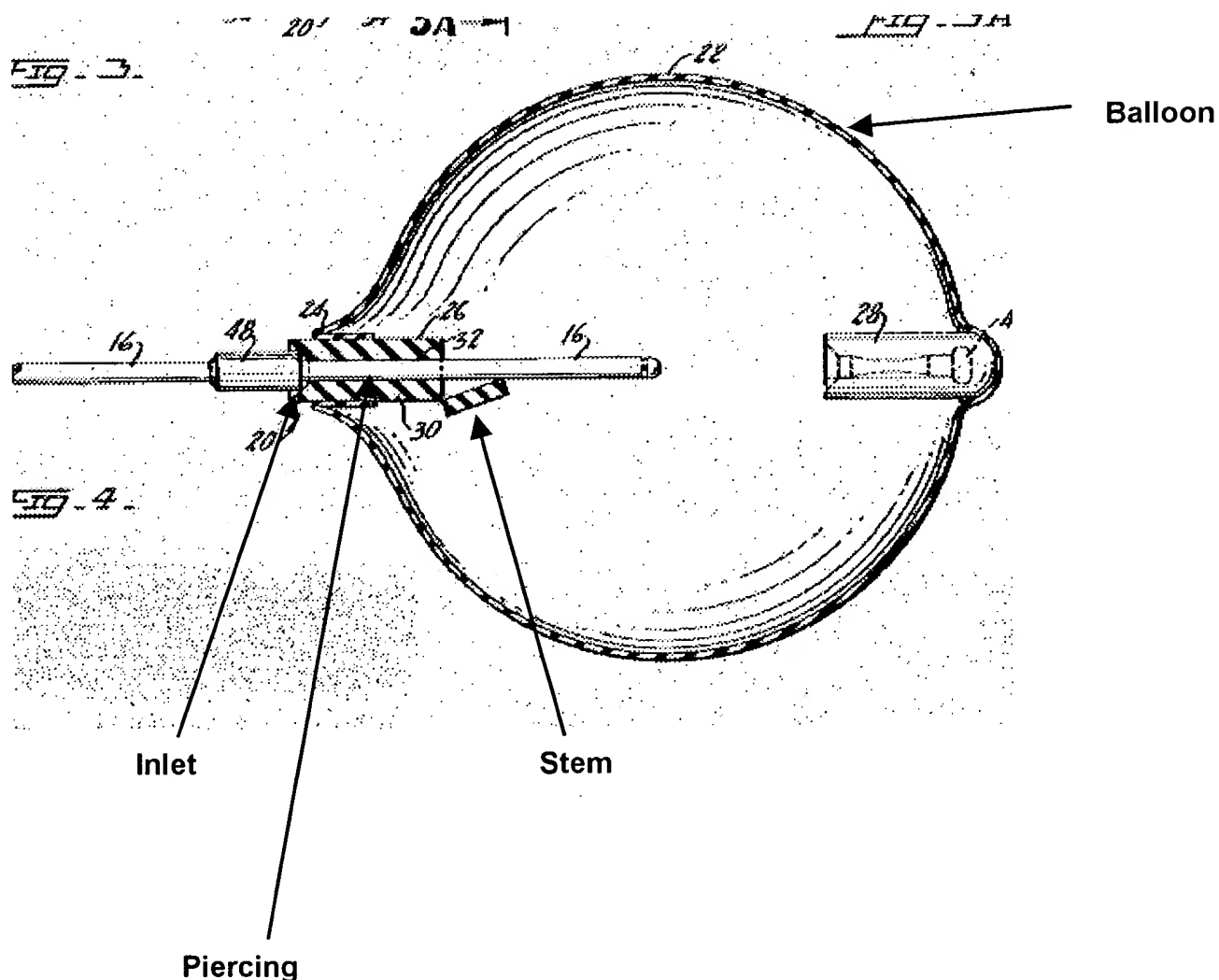
**The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

**A person shall be entitled to a patent unless –**

**(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

**Claims 1, 2, 4-8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Pecenka (4,517,979).**

Pecenka in an implantable balloon discloses (SUMMARY OF THE INVENTION):  
a valve portion (at 20) having: a valve body (at 26) defining an inlet; a valve inlet stem (see illustration of Fig. 4 below) extending from said inlet, through said body opposite said inlet; a piercing (see illustration of Fig. 4 below) extending from said inlet, through said body and stem, said valve portion constructed from a soft, elastomeric material having memory thereby causing said piercing to remain closed and fluid-tight unless penetrated by a relatively rigid member (e.g. 16); a balloon portion (22), integral with said valve portion, constructed and arranged to receive and hold fluids exiting said piercing opposite said inlet.



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With respect to claim 2, Pecenka discloses wherein said valve stem comprises at least one side (note illustration of Fig. 4 above).

With respect to claim 4, Pecenka discloses wherein the valve stem comprises a side and said valve portion (at 20) further has a sidewall, laterally displaced from said valve stem side, and integral with an inside surface of said balloon portion (Figs. 2-5).

With respect to claim 5, Pecenka discloses wherein said valve portion (at 20) is substantially cylindrical (Figs. 2-5).

With respect to claim 6, Pecenka discloses wherein said valve body, said valve stem, and said inlet are substantially cylindrical and substantially concentric (Figs. 2-5).

With respect to claim 7, Pecenka discloses wherein said valve stem comprises at least one side and said piercing extends through said side of said stem (Figs. 2-5).

With respect to claim 8, Pecenka discloses wherein said valve stem comprises a side and said valve portion (at 20) further has a sidewall extending from said valve body, laterally displaced from said valve stem side (Figs. 2-5).

With respect to claim 10, Pecenka discloses wherein said soft, elastomeric material comprises silicone (Col. 3, lines 9-28).

### ***Claim Rejections - 35 USC § 103***

**The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

**Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pecenka (4,545,367).**

The difference between Pecenka and claim 3 is the valve stem having a rounded tip. At the time the invention was made, it would have been an obvious matter of design consideration to a person of ordinary skill in the art to have the valve stem to have a rounded tip because Applicant has not disclosed that having a rounded tip on the valve stem provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the valve tip in other shapes, because the ability to close the opening would not be affected by the shaped of the valve tip. Accordingly, the valve tip having a rounded tip is deemed to be a design consideration, which fails to patentably distinguish over the prior art of Pecenka.

***Allowable Subject Matter***

Claims 52-61 are allowable over the prior art of record.

Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 11 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (571) 272-4798. The examiner can normally be reached on Monday-Friday however the examiner is on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Teena Mitchell  
Primary Examiner  
Art Unit 3743  
June 17, 2006

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